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Paper No. 17

PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Applied Industrial Technologies, Inc.

Serial No. 75/746,326

Robert V. Vickers of Vickers, Daniels & Young for
applicant.

David Gardiner, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Hanak, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On July 9, 1999 Applied Industrial Technologies, Inc.
filed an application to register the mark shown below
for services which were identified as "providing
information via a global computer network about product
information in the field of bearings, power transmission

components, electrical products, industrial belting, fluid power, hydraulic equipment and related items."¹



The Trademark Examining Attorney issued a first office action, that, inter alia, refused registration of applicant's mark on the ground that "the mark is used to identify an activity that does not constitute a 'service' within the meaning of the Trademark Act." The Examining Attorney based this refusal on the specimen that was submitted with the application, which is a printout of a page from applicant's Web site. The Examining Attorney stated, "it appears from the specimens of record that applicant's [W]eb site does not provide general information about [bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic

¹ Application Serial No. 75/746,326, filed July 9, 1999, and asserting first use and first use in commerce in June 1999. The application includes the statement that "The lining shown in the drawing is a feature of the mark and not intended to indicate color."

equipment and related items], but rather merely advertises and provides information about the applicant's own products and services." The Examining Attorney advised applicant that the refusal would be reconsidered if it submitted substitute specimens showing use of the mark for the services set forth in the application. Further, the Examining Attorney advised applicant that the services were properly classified in class 42.

In response to the refusal, applicant proposed to amend the recitation of the services and the classification to "providing information via a global computer network relating to products of others in the field of bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment and related items" in class 42. Applicant stated that it was "a distributor of the goods of others" and that the Web page specimen "evidence[s] that applicant is providing product information relating to the products manufactured by others in the fields recited in the recitation of services." Applicant also submitted as informational materials, printouts of additional Web pages that were accessed through applicant's Web site. These printouts contain information on bearing products and drive systems manufactured by third parties.

The Examining Attorney found the amended recitation of services to be acceptable and also withdrew the refusal to register on the ground that the mark does not function as a service mark. However, the Examining Attorney found the Web page specimen of record to be unacceptable because it "does not show the mark used in connection with the services of providing information." Rather, according to the Examining Attorney, "the specimen merely shows the mark used with a list of goods that the applicant is the distributor of." Thus, the Examining Attorney required applicant to submit a substitute specimen showing the mark used in commerce with the services of providing information about the industrial products of others.

Applicant argued against the requirement for a substitute specimen. According to applicant, a consumer may access from its Web site, Web pages that contain information relating to products of others in the field of bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment and related items. Thus, applicant argued that the Web page specimen of record shows use of the mark in connection with the services, as amended.

The Examining Attorney was not persuaded by applicant's argument and subsequently made final the requirement for a substitute specimen.

Applicant then filed an appeal and submitted a second amendment to the recitation of its services, namely: "providing information, including order status, account history, order history, product specifications, and a searchable database via a global computer network and the information relating to the products of others in the field of bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment, and related items." In addition, applicant argued that the specimen of record showed use of the mark in connection with the services as now amended. However, in the alternative, applicant submitted a substitute specimen. This substitute specimen is a printout of another page from applicant's Web site.

The Examining Attorney found the second amendment to the recitation of services unacceptable. In particular, the Examining Attorney stated that the wording including order status, account history, order history, product specifications, and a searchable database via a global computer network "[is] not within the scope of the identification that was set forth in the application at the

time of filing." The Examining Attorney pointed out that while Trademark Rule 2.71(a) permits an application to be amended to clarify or limit the identification of goods, additions to the identification of goods are not permitted. The Examining Attorney advised applicant that this second amended recitation of services would not be entered in the application. In addition, the Examining Attorney continued the final requirement for a substitute specimen showing use of the mark in connection with the services of providing information about the industrial products of others.

Applicant then filed a request for reconsideration, accompanied by the declaration of Fred D. Bauer, applicant's assistant general counsel and assistant secretary. Applicant continued to argue that the second amended recitation of services was within the scope of the original recitation of services and that the specimens were proper. Mr. Bauer, in his declaration, stated that applicant's mark "is used in connection with providing product information to consumers of Applicant;" and that such information includes technical material and/or specifications for the products sold by applicant and account history information.

The Examining Attorney was not persuaded by applicant's arguments and the declaration of its officer.

The Examining Attorney made final the requirement that applicant amend the recitation of services to set forth services which are within the scope of the original recitation of services. In addition, the Examining Attorney denied applicant's request for reconsideration of the final requirement for a substitute specimen.

Applicant and the Examining Attorney then filed briefs.

The two issues on appeal are (1) whether the second amended recitation of services exceeds the scope of the original recitation of services and thus is permitted under Trademark Rule 2.71(a); and (2) whether the specimens of record show use of the mark for the services set forth in the first amended recitation of services.

We consider first the issue of whether the second amended recitation of services exceeds the scope of the original recitation of services and thus is permitted under Trademark Rule 2.71(a). As noted by the Examining Attorney, Trademark Rule 2.71(a) provides that:

The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.

Applicant's original recitation of services reads:

Providing information via a global computer network about product information in the field of bearings, power transmission components, electrical products; industrial belting, fluid power hydraulic equipment, and related items.

Applicant's second amended recitation of services reads:

Providing information, including order status, account history, order history, product specifications, and a searchable database via a global computer network and the information relating to the products of others in the field of bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment, and related items.

After careful consideration of the arguments of applicant and the Examining Attorney, we find that the second amended recitation of services does exceed the scope of the original recitation of services, and thus is not permitted under Trademark Rule 2.71(a). At the outset, we should point out that neither the original recitation of services or the second amended recitation of services is a model of clarity. Be that as it may, it is nonetheless readily apparent that the additional wording in the second amended recitation of services, i.e., "including order status, account history, order history, product specifications, and a searchable database via a global computer network," substantially broadens the scope of the original recitation of services. We should make clear that

it is not a question of whether applicant is in fact providing information regarding order status, account history, order history, product specifications and a searchable database. Rather, the question is whether these services are within the scope of the original recitation of services. In this regard, we agree with the Examining Attorney's characterization of the original recitation of services as essentially an on-line information service where a user may obtain information about bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment and related items. Also, we agree with the Examining Attorney's characterization of the seconded amended recitation of services as encompassing not only information services pertaining to certain industrial products, but services which are more akin to on-line retailing in the sense that customers are able to obtain information regarding order status, account history, and order history. Moreover, as noted by the Examining Attorney, the wording that has been added in the second amended recitation of services contains no limitations or restrictions as to field. In the absence of any limitations or restrictions, it must be assumed from this wording that the information applicant provides regarding order status, account history, order history,

etc. is not limited to the field of "bearings, power transmission components, etc." There is no question but that this wording expands the field of the services as set forth in the original recitation of services.

In view of the foregoing, we find that the second amended recitation of services is unacceptable.

We turn then to the issue of whether the specimens of record evidence use of the mark in connection with the services set forth in the first amended recitation of services:

Providing information via a global computer network relating to products of others in the field of bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment and related items.²

Applicant has submitted two different web pages as specimens. Our review of these specimens leads us to conclude that neither specimen evidences use of the mark for "providing information via a global computer network relating to products of others in the field of bearings, power transmission components, electrical products, industrial belting, fluid power, hydraulic equipment and related items."

On the first web page specimen, applicant identifies

² As previously indicated, the Examining Attorney found this recitation of services to be acceptable.

itself as "a leading U.S. distributor of bearings, power transmission components, fluid power products, linear technologies, rubber products and a host of specialty items." In addition, on this web page there are icons for the various product categories that enable a customer to search for products, fill his/or her shopping cart and checkout. No information concerning any products is provided on this web page and there are no links to informational web pages as such. Thus, contrary to applicant's argument, this web page does not evidence use of the mark for the services of providing information about the industrial products of others.

As to the second web page specimen, it is in the nature of a login web page, where a user must provide a username and password to enter applicant's Internet procurement system. Again, no information concerning any products is provided on this web page and there are no links to informational web pages as such. In fact, it is stated on this web page that a user "can place an order, search for products, view pricing, check an order status, review [a] contract, and scan [an] account history." Thus, we find that this web page does not evidence use of the mark in connection with the services of providing information about the industrial products of others.

In view of the foregoing, we find that neither specimen evidences use of the mark for the services set forth in the first amended recitation of services.

As a final matter, we should point out that providing information about products that one manufactures or distributes is generally not considered an activity that constitutes a service within the Trademark Act. Thus, where as here, it appears that applicant is a distributor of the industrial products of others; there is at least a question as to whether applicant's providing of information relating to the industrial products of others is an activity that constitutes a service within the Act.

Decision: The refusal to register is affirmed.